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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,812	11/24/2003	Jung S. Kang	42P17606	5364

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Blakely, Sokoloff, Taylor & Zafman LLP
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Costa Mesa, CA 92626

EXAMINER

MITCHELL, JAMES M

ART UNIT	PAPER NUMBER
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2813

MAIL DATE	DELIVERY MODE
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03/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/720,812

Applicant(s)

KANG ET AL.

Examiner

JAMES M. MITCHELL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to applicant's remarks filed December 15, 2008.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 9, 10, 12, 13, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Poddar et al. (U.S. 6,933,597).
4. Poddar (e.g. Fig. 1-3) discloses:
(cl. 9) a spacer (16) to provide clearance for bond wires (not labeled; Fig. 1) attaching to bond pads on the lower die (e.g. spacer lifts top die to access pad/contact on lower chip); a thin-film passive element (e.g. thin enough to be embedded in spacer; Abstract) integrated on the spacer (Col. 3, Lines 11-18); an adhesive layer (Fig. 3-4; 21, 22; plastic mold package body, Col. 2, Lines 56-64)) assembly to attach the spacer and the thin-film passive element to the upper and lower dies (14, 12): and conductors (21, 22) attached to the passive element and the adhesive layer assembly to connect the passive element to at least one of the upper and lower dies:

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(cl. 10, 16) upper adhesive to attach to the upper die and lower adhesive top attach to lower die (e.g. body surrounds chip and in between conductors)¹;

(cl. 12) passive element thickness substantially less than spacer (e.g. can be embedded in spacer thus must be thinner; Abstract);

(cl. 13) passive has multi-turn geometry (e.g. inductor; Col. 3, Lines 11-18);

(cl. 15) conductors are bumps (21, 22) to connect passive to at least one upper and lower dies.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

¹ Note previously cited Fukuda et al. (U.S. 2004/0145040) package showing package surrounding

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7. Claims 11, 14 and 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Poddar et al. (U.S 6,933,597).
8. Poddar discloses the elements stated in paragraph 4 of this office action and further a package substrate (18), but does not disclose the claimed range of inductance/resistance or a plurality of stacked dies.
9. With respect to the passive element being between the spacer and lower adhesive in claim 11, the placement being on top embedded in or on the bottom of the spacer would not modify the operation of the device. As such, the mere shifting of the passive element is unpatentable as a matter of design choice. See e.g. In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice).
10. With respect the claim 14 and 22, the modified prior art discloses the claimed invention except for the claimed range of inductance. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed inductance, since it has been held that where the general working conditions of a claim are disclosed in the prior art, discovering the

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optimum or working ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233 (CCPA 1955).

11. With respect to a there being a plurality of stacks in claim 17, although Poddar appears to show just one stack, examiner takes official notice that use of a plurality of stacks are known for forming various.

12. Furthermore, the duplication of stacks would be obvious to one of ordinary skill in the art, since it has been held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. See e.g. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). MPEP 2144.04.

Response to Arguments

13. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

14. With respect to examiner's taking of official notice, because applicant failed to timely traverse the common knowledge or well-known in the art statement is taken to be admitted prior art.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES M. MITCHELL whose telephone number is (571)272-1931. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mathew Landau can be reached on (571) 272-1731. The

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fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

March 15, 2009
/James M. Mitchell/
Examiner, Art Unit 2813